

II. REMARKS

Before the amendments made herein, claims 32 to 59 were pending. Claims 49, 53 and 55 to 58 have been canceled herein without prejudice. Accordingly, after the amendments made herein are entered, claims 32 to 48, 50 to 52, 54 and 59 will be pending.

A. Regarding the § 112, first paragraph, rejection

Claims 49, 53 and 55 to 58, are rejected under 35 U.S.C. § 112, first paragraph, as allegedly not enabled by the specification. Applicants respectfully traverse the rejection.

The Action alleges that the specification, while enabling for an isolated polynucleotide comprising SEQ ID NO:43, does not reasonably provide enablement for a transgenic organism comprising a host cell recombinantly expressing SEQ ID NO:44.

Applicants are extremely puzzled by this allegation. The rejected claims are directed to a host cell, not a transgenic organism! The fact that these claims may encompass an inoperative embodiment does not matter under the law. See, for example, M.P.E.P. sec. 2164.08(b). Indeed, the vast majority of embodiments encompassed by these claims are to host cells but not transgenic organisms.

If this were not the law, virtually no claim would ever be patentable! It could always be argued, for example, that a novel and inventive chemical is not enabled because a claim to that chemical encompasses a transgenic organism containing that chemical.

Nevertheless, to promote prosecution of this case Applicants have canceled claims 49, 53 and 55 to 58 without prejudice. Accordingly, Applicants respectfully request that this rejection be withdrawn.

B. Regarding the claim objections

Page 2 of the Action states that claims 50 to 52 and 54 are objected to because they depend from rejected claims.

In response, Applicants have either a) changed the dependency to non-rejected claims; or b) made the claims independent (with all the relevant limitations). Accordingly, Applicants respectfully request that the objections be withdrawn.

III. CONCLUSION

All of the issues raised in the Office Action have been addressed and are believed to have been overcome. Accordingly, it is respectfully submitted that all the claims under examination in the subject application are allowable. Therefore Applicants respectfully request a Notice of Allowance to this effect.

Respectfully submitted,



Martin Moynihan

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Encl.:

One-month extension of time

Request for continued examination